REMARKS

I. Status Of The Claim

Claims 1, 3-7, 10, 11, 13 and 14 are pending in the present application. Claims 4 and 5 were previously withdrawn from consideration.

Claims 1, 3 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,190,751 to Sylvester ("Sylvester") in view of U.S. Patent No. 2,383,570 to Sellew ("Sellew"). Claims 6, 7 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sylvester in view of Sellew in view of U.S. Patent No. 791,552 to Hance ("Hance"). Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Sylvester in view of Sellew, and further in view of U.S. Patent No. 5,090,713 to Johnson ("Johnson"). Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Sylvester in view of Sellew in view of Hance, and further in view of Johnson.

Claims 1, 3 and 10 stand rejected under U.S.C. § 103(a) as being unpatentable over Sylvester in view of U.S. Patent No. 5,427,389 to Ishikawa ("Ishikawa"). Claims 6, 7 and 13 stand rejected under U.S.C. § 103(a) as being unpatentable over Sylvester in view of Ishikawa in view of Hance. Claim 11 stands rejected under U.S.C. § 103(a) as being unpatentable over Sylvester in view of Ishikawa, and further in view of Johnson. Claim 14 stands rejected under U.S.C. § 103(a) as being unpatentable over Sylvester in view of Ishikawa in view of Hance, and further in view of Johnson.

II. Rejection Of Claims 1, 3 And 10 Based On Sylvester And Sellew

The Examiner rejected claims 1, 3 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Sylvester in view of Sellew. Applicant traverses this rejection and respectfully submits that these claims are patentable over the cited art for the following reasons.

A. Sellew Does Not Teach Selectively Locating A Lip At A Specific Area Of A Gasket Surface Where Improved Sealing Is Necessary

As a basis for the rejection of claims 1, 3 and 10 under 35 U.S.C. § 103(a), the Examiner has asserted that Sellew teaches selectively using a lip only at a location on a gasket surface where improved sealing is necessary. The Examiner cites the following disclosure in Sellew in support of this assertion.

> In gaskets of the character mentioned, slight imperfections of large area on the flat surface of a flat gasket or in the container gasket seat or on the plug results in non-sealing, because at such imperfection the gasket will not be properly compressed for sealing.
>
> It has been discovered that a comparatively small rib or ridge, such as of $^{1}/_{32}$" in height, requires very little frictional pressure for compression and effective sealing, instead of requiring the entire face of the width of the gasket to produce the actual seal. Col. 2, lns. 28-39.

Applicant respectfully submits that one of ordinary skill in the art would not understand these statements in Sellew or any other disclosure in Sellew as supporting the Examiner's assertion. To the contrary, one of ordinary skill in the art would understand that, consistent with conventional gasket design, Sellew exclusively discloses and teaches a gasket which provides a uniform seal along the entire perimeter of abutting seating surfaces.

1. Sellew Exclusively Discloses And Teaches An Improved Synthetic Rubber Gasket Having At Least One Continuous Rib Which Provides A Fluid-Tight Seal Along The Entire Perimeter Of The Gasket

Sellew is directed to an improved synthetic rubber gasket developed during the World War II era. As described in Sellew, prior to World War II, natural rubber gaskets had been used to provide a fluid-tight seal along the entire perimeter of the contacting surfaces between a plug and a container holding gasoline, oil, water, etc. However, because of the non-

availability of natural rubber material during the war[1] (col. 1, lns. 11-12) and because natural rubber gaskets could not be repeatedly used since the material rapidly deteriorates when exposed to common solvents such as oil, grease and gasoline (col. 1, lns. 19-21), flat-faced synthetic rubber gaskets were developed to provide fluid-tight seals between a plug and container.

As explained in Sellew, these flat-faced synthetic rubber gaskets were problematic because the "gasket required a tremendous amount of friction and pressure to compress the gasket to effect the proper sealing action." Col. 1, lns. 52-55. Sellew further explains that "[o]nce sealed, [the flat-faced synthetic rubber] gaskets could not be readily manipulated manually for unsealing." Col. 1, ln. 55 – col. 2, ln. 2. In addition, Sellew explains that synthetic rubber material was relatively expensive at that time and, as a cost-saving measure, fillers were used to reduce the amount of synthetic rubber material required for the gasket. Col. 2, lns. 3-5. However, the use of these fillers "generally tend[ed] to increase the hardness" of the gasket, which resulted in a gasket with "a greater resistance to hand pressure." Col. 2, lns. 6-12.

It is against this backdrop to which Sellew discloses and describes his improved synthetic rubber gasket in the passages cited by the Examiner at column 2, lines 28-39. In the passage at column 2, lines 28-33, Sellew references the hardness/hand pressure limitations of the prior art flat-faced synthetic rubber gaskets in stating that "slight imperfections of large area of the flat surface of a flat gasket or in the container gasket seat or on the plug result in non-sealing, because at such imperfection the gasket will not be properly compressed for sealing." Sellew then goes on in the passage at column 2, lines 33-39 to state that he "discovered that a

[1] With the Japanese military domination of Southeast Asia following the bombing of Pearl Harbor in December 1941, the U.S. was without access to 90 percent of the world's natural rubber supplies. Nearly all rubber used in North America at that time came from British Malaya, the Netherlands Indies, Ceylon and French Indo-China-areas controlled by or soon to be controlled by Japan.

comparatively small rib or ridge, such as of $^{1}/_{32}$" in height, requires very little frictional pressure for compression and effective sealing, instead of requiring the entire face of the width of the gasket to produce the actual seal." Accordingly, in these passages Sellew identifies the benefits of his improved synthetic rubber gasket compared to the prior art flat-faced synthetic rubber gasket. Specifically, Sellew's synthetic rubber gasket having a relatively small continuous annular rib or ridge required very little frictional pressure for compression to provide an effective seal, whereas the prior art flat-faced synthetic rubber seal required a tremendous amount of frictional pressure for sealing and consequently was also difficult to unseal. The title of the Sellew patent "Hydrocarbon Resistant, Light Pressure Sealing Gasket Structure" plainly characterizes and acknowledges this basic feature of the Sellew gasket.

2. Sellew's Improved Synthetic Rubber Gasket Embodies The Conventional Gasket Design Of Providing A Uniform Sealing Surface Along The Entire Perimeter Of The Seating Surfaces

Each of the prior art natural rubber and flat-faced synthetic rubber gaskets and Sellew's improved synthetic rubber gasket embody the conventional gasket design of a uniform sealing surface which spans the entire perimeter of the abutting seating surfaces.[2] A person of ordinary skill in the art would understand that this fundamental design feature is necessary to provide a fluid-tight seal between the abutting seating surfaces. This is because the number, shape, size, degree and location of imperfections or irregularities to be sealed are unique to each seating surface. This is also because the orientation of the gasket relative to the seating surfaces is arbitrary. For these reasons, one of ordinary skill in the art would readily understand that, like

[2] Indeed, a person of ordinary skill in the art at the time the Sellew patent application was filed would appreciate that Sellew's invention was an adaptation of the then recently patented O-ring technology (U.S. Patent No. 2,180,795 issued on November 21, 1939 to N.A. Christensen) for use in a gasket having a flat-faced seating surface. Like an O-ring, Sellew discloses a gasket having a continuous rib sealing surface along the entire perimeter of the seating surface.

the prior art gaskets, the improved synthetic rubber gasket disclosed in Sellew must include a uniform sealing surface along the entire perimeter of the gasket to effectively seal the abutting seating surfaces.

Indeed, Sellew expressly states that to provide an effective fluid-tight seal, a gasket must provide a seal along any portion of the container or plug seating surfaces having imperfections, as well as any imperfections in the flat gasket surface. Col. 2, lns. 28-33 ("In gaskets of the character mentioned, *slight imperfections of large area* on the flat surface of a flat gasket or *in the container gasket seat or on the plug results in non-sealing, because at such imperfection the gasket will not be properly compressed for sealing.*") Moreover, implicit with this statement is that the gasket must also provide a seal along the portions container or plug seating surfaces having no imperfections. One of ordinary skill in the art would understand that the failure to provide a seal along any portion of the perimeter of the seating surfaces of the container or plug will not result in a fluid-tight seal therebetween. Accordingly, Sellew expressly teaches providing a seal along the entire perimeter of the seating surfaces of the container and plug.

Consistent with this conventional gasket design and express teaching, Sellew unequivocally and exclusively discloses and teaches that his improved synthetic rubber gasket seal is provided by a continuous rib or ridge formed on the flat surface of the gasket.

> To effect proper sealing under the operating conditions previously specified, there is provided on the container confronting face 25 of the gasket a continuous sealing means herein in the form of a concentric ridge 26 near the outer edge of the gasket. Col. 3, lns. 48-53 (emphasis added).

All of the embodiments disclosed in Sellew include continuous seal means in the form of concentric ridges or ribs which span the entire perimeter of the gasket. See Figures 2 and 4-7 (continuous concentric ridges 26, 27, 126, 226, 227 and continuous rib-rings 326, 327).

3. The Examiner's Assertion That Sellew Teaches Using A Lip At Any Location On A Gasket Where Improved Sealing Is Necessary Would Defeat The Principle Of Operation Of The Gasket And Make It Inoperable

Applicant respectfully submits that one of ordinary skill in the art would understand that a gasket embodying the Examiner's proposed teaching of Sellew would not perform the basic gasket function of providing a fluid-tight seal around the entire perimeter of the seating surface. Specifically, one of ordinary skill in the art would understand that a gasket having lips only at locations of imperfections on the gasket face would not provide a fluid-tight seal with the entire perimeter of the seating surfaces. This is because such a gasket fails to provide a seal between the flat portions of the perimeter of the gasket (the portions of the gasket perimeter having no lip) and the seating surfaces of the container and plug, including any imperfections in these seating surfaces.

As expressly disclosed in Sellew, the use of a continuous comparatively small rib around the entire perimeter of his improved synthetic rubber gasket provides a fluid-tight seal which requires very little frictional pressure for compression of the lips. Sellew explains that this use of "very little" frictional pressure overcomes the unique problem associated with the prior art flat-faced synthetic rubber gasket which required a "tremendous" amount of frictional pressure. One of ordinary skill in the art would understand that if this "very little" amount of frictional pressure were applied to a synthetic rubber seal having lips only located along portions of the perimeter of the flat gasket surface, the flat portions of the perimeter (the portions without a lip) would not provide a seal between the abutting seating surfaces of the container or plug.

In addition, the Examiner's assertion of the teaching in Sellew is based on an entirely hypothetical situation devoid of any practical application of gasket design. For example, this concept would only apply to a hypothetical situation where each flat-faced gasket is

individually manufactured, then inspected for imperfections and subsequently modified to include lips in each location of an imperfection. As one of ordinary skill in the art would appreciate, each flat-faced gasket would have unique imperfections which would require a corresponding set of unique lips at various locations on the gasket surface. Accordingly, one of ordinary skill in the art would understand that, for purposes of expediency and ease of manufacture, a gasket should include a uniform sealing surface.

4. The Examiner's Assertion That Sellew Teaches Using A Lip At Any Location On A Gasket Where Improved Sealing Is Necessary Is Directly Contrary To The Objectives And Advantages Of The Invention Expressly Disclosed In Sellew

As set forth in Sellew, the prior art flat-faced synthetic rubber gasket was problematic because it required a tremendous amount of frictional pressure for sealing and consequently was also difficult to unseal. Sellew states that the use of at least one comparatively small continuous rib to provide the seal in his improved synthetic rubber gasket overcomes these problems associated with the prior art flat-faced synthetic rubber gasket because the rib requires very little frictional pressure for compression and effective sealing. Therefore, one of ordinary skill in the art would understand that Sellew teaches an improved synthetic rubber gasket which requires very little frictional pressure to provide effective sealing and ease of unsealing. The Examiner's assertion that Sellew teaches selectively using a lip only at certain portions along the perimeter of the gasket is contrary to these objectives and advantages of Sellew's invention.

One of ordinary skill in the art would readily understand that a gasket having ribs which only span selected portions of the gasket perimeter leaving other flat-faced portions of the gasket perimeter would necessary require even greater frictional pressure to provide an effective fluid-tight seal than the prior art flat-faced synthetic rubber gasket. Specifically, for the gasket to provide a fluid-tight seal, one of ordinary skill in the art would understand that, while very little

frictional pressure would be required for compression of the rib portions, a much greater frictional pressure would be required for compression of the flat-faced portions of the gasket perimeter. In fact, due to the presence of the ribs, the frictional pressure required for compression of the flat-faced portions of the gasket perimeter would exceed the "tremendous" amount of frictional pressure required for effecting sealing of the prior art entirely flat-faced synthetic rubber gasket. This is because a significant frictional pressure must first be exerted to compress or flatten the ribs before the flat-faced portions of the gasket perimeter will even engage the abutting seating surface. Once the flat-faced portions of the gasket perimeter engage the abutting seating surface, further frictional pressure must be applied to provide effective sealing therebetween. Accordingly, the Examiner's assertion that Sellew teaches using a lip at any location on the gasket surface where improved sealing is necessary is antithetical to the objectives and advantages of the invention disclosed in Sellew. If anything, Sellew amounts to a teaching away from selectively using lips only at specific locations on the gasket surface.

For at least these reasons, one of ordinary skill in the art would not understand Sellew as teaching only using ribs at specific locations on the gasket surface where improved sealing is necessary. Rather, one of ordinary skill in the art would understand that Sellew teaches a continuous rib spanning the entire perimeter of the gasket surface to provide a fluid-tight seal consistent with conventional gasket design.

B. One Of Ordinary Skill In The Art Would Not Have Been Motivated To Combine Sellew And Sylvester As Proposed By The Examiner

Applicant respectfully submits that one of ordinary skill in the art would not have been motivated to combine Sylvester and Sellew as proposed by the Examiner. Specifically, one of ordinary skill in the art would have had no reason or motivation to modify the gasket of

Sylvester to incorporate any teaching of improved teaching in Sellew because there would have been no expected benefit or advantage in doing so.

As discussed above, Sellew discloses a gasket having a flat synthetic rubber substrate with at least one comparatively small continuous rib which provides a fluid-tight seal along the entire perimeter of the abutting seating surface. As clearly explained in Sellew, this improved synthetic rubber gasket was designed to overcome the sealing deficiencies of the prior art flat-faced synthetic rubber gasket. Specifically, because the synthetic rubber material was relatively hard it would only compress to seal imperfections in the seating surfaces if a tremendous amount of frictional pressure were applied. Sellew explains that the relatively small surface area of the comparatively small continuous rib requires very little frictional force to compress the rib against the seating surfaces of the container or plug and, thus, eliminates the problems associated with the prior art flat-faced synthetic rubber gasket which required an excessive amount of frictional pressure to provide an effective seal.

Sylvester is directed to an improved reinforced foam gasket having (1) a substrate comprising a flexible polymeric film reinforcement layer 34 and (2) a flexible foam sealing layer 32 thermally bonded to the polymeric film reinforcement layer and which provides the seal with the abutting seating surface.. Sylvester discloses that reinforcement layer 34 allows the face of the symmetrical, flat, flexible foam layer 32 to be properly compressed against and sealed with the seating surface. The distinguishing inventive feature disclosed in Sylvester is the use of thermal bonding to secure the flexible foam sealing layer 32 to the polymeric film reinforcement layer, instead of the use of pressure sensitive adhesive 13. Sylvester explains that the use of pressure sensitive adhesive 13 in the prior art foam gaskets was disadvantageous because (1) it did not sufficiently secure foam sealing layer to polymeric film reinforcement layer and (2)

plasticizer in the foam sealing layer tended to bleed through the pressure sensitive adhesive layer 13.

Applicant respectfully submits that one of ordinary skill in the art would not even have been motivated to apply any teaching of Sellew to modify the foam gasket of Sylvester as proposed by the Examiner. First, one of ordinary skill in the art would appreciate that the teaching of Sellew of providing a comparatively small continuous rib sealing surface is a solution to a problem that is unique to gaskets formed of relatively hard material such as synthetic rubber. For example, Sellew did not disclose, teach or suggest adding a comparatively small continuous rib along the perimeter of a natural rubber gasket. There was no need for this because the prior art flat-faced natural rubber gasket provided an effective seal without requiring an excessive amount of frictional pressure. The same is true for the foam gasket in Sylvester. There would be no need to include a comparatively small continuous rib on the Sylvester foam gasket because the foam sealing layer provides an effective seal without requiring an excessive amount of frictional pressure.

Second, as expressly disclosed in Sylvester, there was no sealing problem with foam gaskets. Sylvester disclosed that prior art foam gaskets suffered a sealing problem due to the stretching and distortion of the foam material. However, Sylvester further disclosed that this sealing problem was previously solved by including a polymeric film reinforcement layer to support the foam sealing layer. Sylvester discloses the use of this polymeric film reinforcement layer in both the prior art embodiment shown in Figure 1 (polyester film layer 14) and Sylvester's preferred embodiment shown in Figure 3 (polymeric film reinforcement layer 34). Accordingly, the foam gasket disclosed in Sylvester did not suffer any sealing problem which would have motivated or given one of ordinary skill in the art any reason to further modify to the

foam gasket to include lips as suggested by the Examiner. The Examiner's proposed combination of Sylvester and Sellew amounts to nothing more than pure hindsight reconstruction using the pending claims as a template.

C. A Combination Of Sylvester And Sellew Would Not Yield The Invention Recited In Claims 1, 3 And 10

The Examiner has asserted that it would have been obvious to one of ordinary skill in the art to modify Sylvester to include a lip along only a portion of the perimeter of the gasket to provide improved sealing. Presumably, the Examiner has asserted that the lip would be located on the surface of the flexible foam sealing layer 32 of Sylvester. As provide above, applicant respectfully submits that one of ordinary skill in the art would not have been motivated to combine any teachings of Sellew with Sylvester. However, even assuming *arguendo* that one of ordinary skill in the art would have been motivated to apply the teachings of Sellew to modify Sylvester, applicant respectfully submits that one of ordinary skill in the art would not have arrived at the Examiner's proposed combination of Sylvester and Sellew. Rather, the result of such a combination would have been the use of the ribs disclosed in Sellew in place of the flexible foam sealing layer in Sylvester. This would yield an annular gasket having a polymeric film reinforcement layer with one or more comparatively small continuous ribs extending along the entire perimeter of the gasket. Such a gasket fails to disclose, teach or suggest a seal with at least one lip on a first portion of the first side of a sheet of flexible material and no lip on a second portion of the first side of the sheet of flexible material as specified in the pending claims.

D. Even Assuming The Examiner's Interpretation Of The Teaching Of Sellew Is Correct, The Proposed Combination Of Sylvester And Sellew Does Not Yield The Invention Recited In Claims 1, 3 And 10

Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case that the invention recited in claims 1, 2 and 10 is obvious. *In re Oetiker*, 977 F.2d

1443, 1445 (Fed. Cir. 1992). Specifically, the Examiner has failed to demonstrate that either Sellew or Sylvester, alone or in combination, disclose teach or suggest that "the at least one lip provides a point of compression against the abutting surface of the optical unit and produces a compressive force between the optical unit and the surface of the second portion of the first side of the sheet of flexible material."

In contrasting the prior art synthetic rubber gasket with his improved synthetic gasket, Sellew explains that one of the benefits of his invention is that "very little frictional pressure and compression" is required for the comparatively small continuous rib to provide "effective sealing" along the entire perimeter of the abutting seating surfaces. Col. 2, lns. 34-39. Sellew further discloses that the entire compressive force resulting from the tightening of the plug via the complimentary plug threaded surface 15 and the container threaded surface 12 is applied on the rib to provide the seal between the plug and container. Therefore, even if Sylvester were modified as proposed by the Examiner to include only a lip where improved sealing is required, Sellew fails to disclose, teach or suggest that the lip "produces a compressive force between the optical unit" and a portion of the sheet of flexible material having no lip.

Applicant respectfully submits that the Examiner has admitted this much in asserting that Sellew teaches locating a lip at a location where improved sealing is required. As asserted by the Examiner, Sellew discloses and teaches that the compressive sealing force is applied only on the portion of the gasket having the rib. Sellew contains no disclosure, teaching or suggestion that this point of compression between the rib/ridge and the plug seating surface "produces a compressive force" between the a seating surface of the plug and a portion of the gasket having no rib. Indeed, Sellew teaches against any such compressive force because if it

did exist the gasket "could not be readily manipulated manually for unsealing." Col. 1, ln. 52 – col. 2, ln. 2.

For purposes of advancing the prosecution of the pending claims and for clarifying the record for appeal, applicant respectfully requests that the Examiner identify the disclosure, teaching or suggestion in Sellew or Sylvester which satisfies the claim limitation which specifies that "the at least one lip provides a point of compression against the abutting surface of the optical unit and produces a compressive force between the optical unit and the surface of the second portion of the first side of the sheet of flexible material."

III. Rejection Of Claims 6, 7 And 13 Based On Sylvester, Sellew And Hance

The Examiner rejected claims 6, 7 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Sylvester in view of Sellew in view of Hance. Specifically, the Examiner has asserted that Hance teaches the use of a reinforcement material either throughout or just in a portion of the body of a gasket and that it, therefore, would have been obvious to one of ordinary skill in the art to further modify Sylvester to include a reinforcement material only in the center portion of the body of the gasket. In addition to the reasons set forth above for traversal of the Examiner's rejection of claims 1, 6 and 10 as being obvious over Sylvester and Sellew, applicant further disagrees with the Examiner's interpretation and application of Hance.

Applicant respectfully submits that Hance does not disclose, teach or suggest a gasket having a reinforcement material "just in a portion" of the gasket body as proposed by the Examiner. To the contrary, Hance exclusively discloses the use of a wire mesh layer and/or canvas layer(s) throughout the entire body of the natural rubber gasket for reinforcement. Hance does not include any disclosure, teaching or suggestion that this reinforcement layer need not apply to any portion of the body of the gasket. Indeed, the two embodiments disclosed in Hance

illustrated in Figures 1-3 each have at least one layer of reinforcement material extending throughout the gasket body. As described at page 1, lns. 49 – 56, Figure 1 discloses a top view of the gasket with a partial cut-away in the middle section to show the wire mesh layer that extends throughout the entire body of the gasket. Figure 2 shows a side section view of the first embodiment of the invention along line 2—2. This side section view clearly shows that the wire mesh area extends in the extreme side sections of the gasket body. Similarly, Figure 3 shows a side section view of the second embodiment of the invention having a wire mesh layer and two canvas layers extending through the extreme side sections of the gasket body.

Further, applicant respectfully submits that one of ordinary skill in the art would not have been motivated to modify the gasket disclosed in Sylvester by selectively including a reinforcement material only in the center portion of the gasket body. As discussed above, Sylvester discloses a gasket having a polymeric film reinforcement layer 32. Sylvester further discloses that this reinforcement layer was included to improve the prior art foam gaskets to provide durability by preventing the foam sealing layer from stretching or distorting. See, col. 1, lns. 26-36. Accordingly, unlike the prior art natural rubber gasket in Hance, the foam gasket disclosed in Sylvester already includes a reinforcement layer. This being the case, one of ordinary skill in the art would not have been motivated to impart any teaching in Hance to further modify the foam gasket disclosed in Sylvester. Moreover, even assuming *arguendo* that one of ordinary skill in the art would be motivated to modify Sylvester based on the teachings of Hance, the result would be a gasket having an additional reinforcement layer extending throughout the entire body of the gasket.

IV. Rejection Of Claim 11 Based On Sylvester, Sellew And Johnson

The Examiner rejected claim 11 under 35 U.S.C. § 103(a) as being unpatentable over Sylvester in view of Sellew, and further in view of Johnson. Applicant respectfully traverses this rejection on the same grounds provided above in response to the Examiner's rejection of claims 1, 3 and 10 based on the proposed combination of Sylvester and Sellew.

V. Rejection Of Claims 14 Based On Sylvester, Sellew, Hance And Johnson

The Examiner rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over Sylvester in view of Sellew in view of Hance, and further in view of Johnson. Applicant respectfully traverses this rejection on the same grounds provided above in response to the Examiner's rejection of claims 6, 7 and 13 based on the proposed combination of Sylvester, Sellew and Hance.

VI. Rejection Of Claims 1, 3 And 10 Based On Sylvester And Ishikawa

The Examiner rejected claims 1, 3 and 10 under U.S.C. § 103(a) as being unpatentable over Sylvester in view of Ishikawa. Central to the Examiner's rejection is the assertion that "Ishikawa teaches a gasket with sealing lips 12b used to improve the seal between bolt holes." Applicant respectfully submits that the Examiner's rejection is based on a substantive error in the characterization of the disclosure in Ishikawa and that claims 1, 3 and 10 are clearly distinguished over any possible combination of Sylvester and Ishikawa.

Ishikawa discloses a metal laminate gasket G comprising four metal plates, upper plate 11, middle plates 12, 13, and lower plate 14. As disclosed in Ishikawa, middle plate 12 includes sealing beads 12a which extend around the perimeter of each cylinder bore Hc. When proper compression force is applied by tightening the bolts (which couple the gasket to the cylinder head/cylinder block), the sealing beads 12a provide a fluid-tight seal around the entire

perimeter of each cylinder bore Hc. Accordingly, Ishikawa exclusively discloses and teaches sealing the entire perimeter of each cylinder bore Hc using a conventional gasket design.

Ishikawa further discloses that there were problems associated with applying an equal distribution of compression force over the surface of the plates when the bolts were tightened. This resulted in the deformation of the gasket plate and insufficient compression force across the sealing beads 12a to effectively seal the cylinder bores Hc. To overcome this problem, Ishikawa discloses the use of edge support beads 12b in plate 12. These edge support beads 12b extended along opposite lateral sides of gasket plate 12 and ensured equal distribution of compression force on the gasket surface when the bolts are tightened. The use of the edge support beads 12b prevented deformation of the gasket plates and provided sufficient compression to effectively seal the seal beads 12a around the perimeter of the cylinder bores Hc.

Applicant respectfully submits that the Examiner has incorrectly identified edge support beads 12b as corresponding to the "lips" recited in the pending claims. As noted above, Ishikawa discloses the use of conventional seal means in the form of sealing beads 12a which extend around the entire perimeter of the cylinder bore Hc. As clearly disclosed in Ishikawa, one of ordinary skill in the art would understand that edge support beads 12b do not perform any sealing function. Accordingly, for at least this reason, applicant respectfully submits that the Examiner's proposed combination of Sylvester and Ishikawa fails to disclose, teach or suggest the invention of pending claims 1, 3 and 10.

VII. Rejection Of Claims 6, 7 And 13 Based On Sylvester, Ishikawa And Hance

The Examiner rejected claims 6, 7 and 13 under U.S.C. § 103(a) as being unpatentable over Sylvester in view of Ishikawa in view of Hance. Specifically, the Examiner has asserted that Hance teaches the use of a reinforcement material either throughout or just in a

portion of the body of a gasket and that it, therefore, would have been obvious to one of ordinary skill in the art to further modify Sylvester to include a reinforcement material only in the center portion of the body of the gasket. In addition to the reasons set forth above for traversal of the Examiner's rejection of claims 1, 6 and 10 as being obvious over Sylvester and Ishikawa, applicant further disagrees with the Examiner's interpretation and application of Hance.

Applicant respectfully submits that Hance does not disclose, teach or suggest a gasket having a reinforcement material "just in a portion" of the gasket body as proposed by the Examiner. To the contrary, Hance exclusively discloses the use of a wire mesh layer and/or canvas layer(s) throughout the entire body of the natural rubber gasket for reinforcement. Hance does not include any disclosure, teaching or suggestion that this reinforcement layer need not apply to any portion of the body of the gasket. Indeed, the two embodiments disclosed in Hance illustrated in Figures 1-3 each have at least one layer of reinforcement material extending throughout the gasket body. As described at page 1, lns. 49 – 56, Figure 1 discloses a top view of the gasket with a partial cut-away in the middle section to show the wire mesh layer that extends throughout the entire body of the gasket. Figure 2 shows a side section view of the first embodiment of the invention along line 2—2. This side section view clearly shows that the wire mesh area extends in the extreme side sections of the gasket body. Similarly, Figure 3 shows a side section view of the second embodiment of the invention having a wire mesh layer and two canvas layers extending through the extreme side sections of the gasket body.

Further, applicant respectfully submits that one of ordinary skill in the art would not have been motivated to modify the gasket disclosed in Sylvester by selectively including a reinforcement material only in the center portion of the gasket body. As discussed above, Sylvester discloses a gasket having a polymeric film reinforcement layer 32. Sylvester further

discloses that this reinforcement layer was included to improve the prior art foam gaskets to provide durability by preventing the foam sealing layer from stretching or distorting. See, col. 1, lns. 26-36. Accordingly, unlike the prior art natural rubber gasket in Hance, the foam gasket disclosed in Sylvester already includes a reinforcement layer. This being the case, one of ordinary skill in the art would not have been motivated to impart any teaching in Hance to further modify the foam gasket disclosed in Sylvester. Moreover, even assuming *arguendo* that one of ordinary skill in the art would be motivated to modify Sylvester based on the teachings of Hance, the result would be a gasket having an additional reinforcement layer extending throughout the entire body of the gasket.

VIII. Rejection Of Claim 11 Based On Sylvester, Ishikawa And Johnson

The Examiner rejected claim 11 under U.S.C. § 103(a) as being unpatentable over Sylvester in view of Ishikawa, and further in view of Johnson. Applicant respectfully traverses this rejection on the same grounds provided above in response to the Examiner's rejection of claims 1, 3 and 10 based on the proposed combination of Sylvester and Ishikawa.

IX. Rejection Of Claim 14 Based On Sylvester, Ishikawa, Hance And Johnson

The Examiner rejected claim 14 under U.S.C. § 103(a) as being unpatentable over Sylvester in view of Ishikawa in view of Hance, and further in view of Johnson. Applicant respectfully traverses this rejection on the same grounds provided above in response to the Examiner's rejection of claims 6, 7 and 13 based on the proposed combination of Sylvester, Ishikawa and Hance.

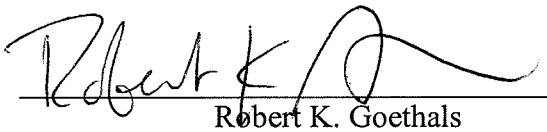
CONCLUSION

Applicant requests reconsideration of the pending claims in view of the foregoing remarks and respectfully submits that the present application is in condition for allowance.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Response to Deposit Account No. 50-4827, Order No. 1004286-818US.

Respectfully submitted,
LOCKE LORD BISSELL & LIDDELL, L.L.P.

Dated: October 27, 2009 By: 

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